

REMARKS

Claim 2 is amended.

Claims 16-54 are withdrawn without prejudice.

Claims 55-69 are newly added.

REJECTION UNDER 35 USC §103(a)

The Examiner rejected Claims 1-15 under 35 U.S.C. 103(a) as being unpatentable over Leatherman, U.S. Patent No. 5,544,044. In support of the rejection, the examiner alleges that Leatherman disclosed a system comprising software prompting claim data input, utilizing a network of computers as claimed except explicitly disclosing worker's compensation claims. The Examiner further asserts that Leatherman teaches that the system is for any type of claims, and therefore one of ordinary skill in the art would have been motivated to include worker's compensation claims in order to carry out the reporting and updating of all types of medical claims. The examiner further refers to Figures 2a items 3,4,5,11,12,19+ and col. 3 lines 1-5.

A claimed invention is *prima facie* obvious when three basic criteria are met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference or combined references must teach or suggest all the claim limitations.

It is respectfully submitted that Leatherman fails to teach or suggest all the limitations of claim 1, and that there is no motivation for modifying Leatherman in the manner proposed by the examiner.

The primary reference to Leatherman teaches a system and method for managing and processing insurance claims that implement a graphic user interface. However, the Leatherman system is not for "any type of claims" as asserted by the examiner. More specifically, as the

Leatherman states in the abstract, "A software-based medical information system performs a method of *analyzing health care claims* records for an enrolled population (e.g., HMO, Medicaid) *to assess and report on quality* of care based on conformance to nationally recognized medical practice guidelines or quality indicators. The system *analyzes health care* received by enrollees having a specified health care condition by: providing to the system health care claims records for a selected enrollee population; defining at least one health care condition in terms of health care events reportable in health care claims records; identifying in the health care claims records those enrollees meeting the definition for that health care condition; defining health care quality criteria for that health care condition in terms of health care events reportable in health care claims records; comparing the health care quality criteria for the at least one health care condition to the health care claims records for at least a portion of those enrollees meeting the definition for that health care condition; and developing and outputting from the system a health care quality report based on the comparison and formulating action recommendations to improve care. The system provides an efficient means to supplement claims data with data from patient medical records (*emphasis provided*)."

Thus, Leatherman, essentially, teaches a computerized method for a medical provider to assess and report on quality of care based on conformance to nationally recognized medical practice guidelines or quality indicators, which has nothing to do with verifying workers' compensation claims. Additionally, Leatherman does not teach receiving data and determining therefrom if there exists a workers' compensation claim number and if there is a match then supplying the claim number to the services provider and if there is no number then reporting to the payor of services that a claim exists without a claim number, as presently claimed.

Given that the two systems are distinct and that Leatherman does not disclose the essential elements of the invention as claimed, it is respectfully requested that the examiner provide a reference that teaches or suggests the step of "...matching workers' compensation claim number, the workers' compensation claims verification system is adapted to supply the matching workers' compensation claim number to the provider computer, if there is no matching workers' compensation claim number, the workers' compensation claims verification system is

adapted to produce an indication of the lack of the workers' compensation claim number" (claim 1)."

Lack of Motivation for Modifying Leatherman

The examiner further implies that that to include worker's compensation claims in order to carry out the reporting and updating of all types of medical claims would provide sufficient motivation for one of ordinary skill in the art to alter the process step lacking in Leatherman. However, as noted previously, Leatherman teaches a computerized method for medical companies to process its internal reports on quality of care based on conformance to nationally recognized medical practice guidelines or quality indicators. Thus, Leatherman does not require, nor would one be motivated to incorporate in its system: "matching workers' compensation claim number, the workers' compensation claims verification system is adapted to supply the matching workers' compensation claim number to the provider computer, if there is no matching workers' compensation claim number, the workers' compensation claims verification system is adapted to produce an indication of the lack of the workers' compensation claim number." Because Leatherman does not require matching a workers' compensation claim number, Leatherman does not suggest or motivate one of ordinary skill in the art at the time of invention, to do what the present invention basically teaches: a Workers' Compensation claim verification system that searches an associated database by querying it with the relevant data provided from the provider computer and if a matching Workers' Compensation number is found, a claim number response would be sent from the verification system back across the Internet to the provider, whereas if no matching number were found the verification system would produce an indication such as an early e-mail alert to the payor computer. (see, pg. 8, lines 24-26 and pg. 9, lines 4-9, claim 1 and claim 2 currently amended). The indication may also be a signal to other software systems co-located with the workers' compensation claims verification system (Claim 3).

In Yamanouchi Pharmaceutical Co. v. Danbury Pharmacal, Inc., 231 F. 3d. 1339, 56 USPQ2d. 1641 (Fed. Cir. 2000), the court reflected on the importance of suggestion or motivation to combine references in an obviousness analysis by stating:

an examiner ... may often find every element of a claimed invention in the prior art. If identification of each claimed element of the prior art was sufficient to negate patentability, very few patents would ever issue. Furthermore rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner ... to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention ... To counter this potential weakness in the obviousness construct, the suggestion to combine requirements stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness. *Id.* at 1644, quoting *In re Rouffet*, 149 F.3d 1350, 1357-58, 47 USPQ 2d 1453, 1457 (Fed. Cir. 1998)

Respectfully, applicant further submits that the examiner has impermissibly used the instant invention as a blueprint to modify the Leatherman to include the claimed element and steps of verification, supplying of claim number and if no matching number than providing an indication verification element and step to arrive at the instant invention. If Leatherman does not disclose a claim verification system, it is not clear how anyone would be motivated to append such a sub-system or function to Leatherman.

It is respectfully submitted that the limitation in claim 1 of receiving "at least some of the data and to determine therefrom any matching workers' compensation claim number, if there is a matching workers' compensation claim number, the workers' compensation claims verification system is adapted to electronically supply the matching workers' compensation claim number to the provider computer, if there is no matching workers' compensation claim number, the workers' compensation claims verification system is adapted to produce an indication of the lack of the workers' compensation claim number" is not capable of indisputable, instant and unquestionable demonstration. It is certainly not evident in Leatherman, the one reference provided. Applicant therefore respectfully requests that the examiner provide a reference that teaches or suggests this step as set forth in claim 1.

In view of the foregoing, applicant respectfully submits that the examiner has failed to show why one of ordinary skill in the art at the time of invention would have been motivated to

modify the system or method of Leatherman to include the claimed verification, supplying of claim number and if no matching number than providing an indication.

3. Leatherman Lacks all the Limitations of Claim 1

Before the prior art reference can be combined with an element of the present invention the examiner must submit at least one reference showing the overall combination as claimed; that is, a basic teaching or basic reference must be shown to exist. Leatherman alone does not show the overall combination, with the claimed element and steps of verification, supplying of claim number and if no matching number than providing an indication verification to arrive at the instant invention.

Claim 2 has been amended so as to overcome the examiner's rejection based upon the current message reading upon any message.

With regard to claims 3-15, The examiner indicates that any specific information such as claim number, social security number and type of injuries would have been inputted and exchanged, if not explicitly in Leatherman then by one of ordinary skill in the art. However, the current invention is drawn to a workers' compensation verification system and its role in providing a means for providers of medical services to obtain payment. As such it would be a requirement of such systems to supply claim number, social security number and type of injuries as part of the records that flow after verification or simultaneously therewith. The Applicant is unaware of a reference that teaches a workers' compensation system that includes these elements. Applicant therefore respectfully requests that the examiner provide a reference that teaches or suggests this step as set forth in claim 3-15 that also deal with the independent claim limitations. Note, however that in regard to claims 3-15, these claims ultimately depend from claim 1, which has been shown to be allowable. Accordingly, claims 3-15 are also allowable by virtue of their dependency upon an allowable base claim.

In view of the foregoing, claims 1-15 are not unpatentable under 35 USC §103(a) in view of Leatherman and Applicant respectfully requests reconsideration, withdrawal of the rejection and allowance of claim 1-15.

V. Claim Amendments

Applicant has submitted amendments to claim 2 to more clearly state the invention. No new matter has been added by the amendment to the claim. Applicant further submits that the substance of the originally filed claims 1 and 3-15 have not been amended and not been made to overcome any prior art cited by the examiner. Accordingly, the amendments made are not related to patentability and do not alter or limit the substance of the subject matter claimed.

VI. Conclusion

It has been shown that the claimed invention distinguishes over the express and implied teachings of the prior art cited of record in the application, and in particular, distinguishes over the express and implied teachings of Leatherman. Having addressed the examiner's rejections to the claims under 35 USC §103, applicant submits that the reasons for the examiner's rejection have been overcome and can no longer be sustained. Applicant respectfully requests reconsideration, withdrawal of the rejections and that a Notice of Allowance be issued.

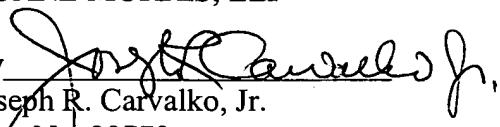
Please inform the applicant if the examiner differs in that view. Should any unresolved issues remain, the Examiner is invited to call Applicant's attorney at 212-692-1052.

VII. Fees

Fifteen new claims have been added bringing the total independent claims pending to three and the total number of claims to thirty. One hundred and eighty (\$180.00) dollars for new claim fees are due. An extension for response within the first month is requested and a fee due is \$110. The Commissioner for Patents is hereby authorized to charge any additional fees or credit any excess payment that may be associated with this communication to Duane Morris LLP deposit account **50-2061**.

Respectfully submitted,

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